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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,767

03/11/2004

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09/14/2007

EXAMINER

MANOHARAN, VIRGINIA

ART UNIT

PAPER NUMBER

1764

MAIL DATE

DELIVERY MODE

09/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/798,767

Applicant(s)

BRITT, MICHAEL L.

Examiner

Virginia Manoharan

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed “..the second solvent takes the place of the first solvent in being held by the reservoir..” is nowhere in the specification. However if support can be pointed- out at least the specification fails to provide proper antecedent basis for the above claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

That the second solvent takes the place of the first solvent in being held by the reservoir, and on the same breadth being flowed through the material in the extraction tank, distilled off in the distillation tank, and returned by the return line to the reservoir provides for ambiguity and confusion. The terms “ being held in the reservoir” would presupposed that the solvent stays in the reservoir, and not go through the process e.g., of flowing, distilling and returning as subsequently recited in claim 17.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1764

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al (5,980,964) and Haefele et al (5,998,640).

The above references are applied for the same combined reasons as set forth at the paragraph bridging pages 2 and 3.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walters et al (5,980,964) and Haefele et al (5,998,640) and with or without Marks et al (5,308,452).

The above references are applied for the same combined reasons as set forth at the paragraph bridging pages 3 and 4 of the previous Office action.

Applicant's arguments filed June 22, 2007 have been fully considered but they are not persuasive.

The claimed "oil collection tank connected to both the distillation tank of the first system and the distillation tank of the second system for collecting the oil from both distillation tanks" recited in claim 14 is deemed to be an obvious variation of the single oil collector for a single distillation column of the prior art, e.g., to Haefele, noting col. 3, lines 61-62 and/or col. 7, lines 55-56. It is within the purview of an artisan to install an oil collector for each column or one collector for both columns for economic reasons.

It is noteworthy that Walters' teaching at col. 4, lines 34-39, that "of course if too much oil still remains after first extraction then it may be subjected to one or more additional extraction cycles" telling an artisan that it's a matter of additive. To tie-in an additional

distillation tank to an existing, available oil collection tank (currently tie-in to one distillation tank), if warranted, is not unobvious.

Haefele, for example, discloses all the elements in the claimed structure in the same cooperative relationship. The fact that Haefele discloses only one system, with its own reservoir, extraction tank, distillation tank, return line, and oil collection tank; and not suggests two extraction systems as argued, much less a common oil collection tank connected simultaneously to both distillation columns as further argued, are of no patentable moment. It is not ascertained whether the particular claimed configuration, i.e., a common oil collection tank for two distillation columns is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of utilizing and /or sharing one collection tank for economic reasons. Moreover, and contrary to applicant's assertion, Marks' second solvent does take the place of the first solvent as claimed. See col. 3, lines 18-19 of the Marks reference disclosing that "the surrogate solvent replaces the desired solvent distilled". The further argued "flowed through the material in the extraction tank (12) as claimed, distilled from the distillation tank (24) as claimed, or returned to the reservoir (28) as claimed" are known as taught e.g., by Haefele. Applicant is arguing the references individually where the rejection is based on a combination of references. Furthermore, the above argued function in Marks of permanently diluting the waste liquid (col. 11, lines 1-4), although not required by the claims, is not excluded therefrom.

Absolute predictability is not a prerequisite for obviousness rejection. All that is required to show obviousness is that the applicant make his claimed invention merely by applying.

knowledge clearly present in the prior art. Section 103 requires us to presume full knowledge by the inventor of the prior art in the filed of his endeavor. See In re Winslow, 53 CCPA 1574, 1578, 365 F.2d 1017, 1020, 151 USPQ 48, 50-51 (1966). No commercial success is claimed, nor is any other factor indicating nonobviousness shown to exist.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Manoharan whose telephone number is (571) 272-1450.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
VIRGINIA MANCHIAN  
PRIMARY EXAMINER  
ART UNIT 125/1764